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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054629
Party	Defendant Wohali Outdoors, LLC
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Submission	Motion to Suspend for Civil Action
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Signature	/S. Max Harris/
Date	11/01/2013
Attachments	11-01-13 - Motion to Stay - Final & Submitted.pdf(27371 bytes) 11-01-13 - Ex 1 - Motion to Stay - Final & Submitted.pdf(509064 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3,904,929)	
SHELTERED WINGS, INC.)	Cancellation No. 92054629
Petitioner/Plaintiff,)	
v.)	
WOHALI OUTDOORS, LLC)	
Respondent/Defendant.)	

**RESPONDENT’S MOTION TO SUSPEND PROCEEDINGS
PENDING THE OUTCOME OF A CIVIL ACTION**

Respondent/Defendant, Wohali Outdoors, LLC (“Wohali”), moves the Court to suspend the current Cancellation proceeding pursuant to 37 CFR § 2.117 and TBMP 510, pending the outcome of the civil action filed by Wohali in State Court. In support, Wohali submits the following.

1. On October 31, 2013, Wohali filed a Petition in Oklahoma State Court seeking monetary damages, punitive damages, and injunctive relief from Petitioner/Plaintiff, Sheltered Wings, Inc. (“Wings”). (Ex. 1, Petition.) As the Petition makes clear, Wohali’s suit is premised on Wings’ bad faith and malicious acts which have interfered with Wohali’s expectancy, business relations and prospective economic advantage. Wohali has further alleged claims for abuse of process and unfair competition.

2. Pursuant to TBMP § 510.02(a) and 37 CFR § 2.117, Wohali moves to suspend Cancellation Proceeding No. 92054629 until the above referenced civil action is resolved. Any determinations made in the civil action will impact this Cancellation proceeding.

“Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.”

TBMP § 510; 37 CFR 2.117(a).

“Further, pursuant to 37 CFR § 2.117(a), the Board may also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved [Note 3], **or a civil action pending between the parties in a state court** [Note 4]...”

TBMP § 510.02(a), at para. 3 (emphasis added).

“PTO proceedings on the cancellation petition were then suspended for some months pending the disposition of related state and federal litigation. At the state level, Mama's and its affiliated company, Mama's Pizza Franchise Company, sought an injunction in a Texas state district court to prohibit Mother's Restaurants of Texas, Inc. (MRT) (a licensee of MRI) from using the name MOTHER'S PIZZA PARLOUR or any similar name in its restaurant, then under construction.”

Mother's Restaurant Inc. v. Mama's Pizza, Inc., 723 F.2d 1566.

3. Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding is related. TBMP § 510.02(a).

“Thus, the civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the board.”

New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc., 99 USPQ2d 1550 (TTAB 2011).

4. Here, the State Court suit is related to the matters before this Board. (See Ex. 1.) See also TBMP § 510.02(a), footnote 7. (*Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974) (decision in **civil action for infringement and unfair competition would have bearing on outcome of Trademark Act § 2(d) claim before Board**)).

Wings has not advised whether it objects to this motion.

Wohali moves the Board to suspend this Cancellation proceeding until there is a final determination of the civil action (Ex. 1).

Respectfully Submitted,

DOYLE HARRIS DAVIS & HAUGHEY

/s/ S. Max Harris

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Attorneys for Wohali

CERTIFICATE OF SERVICE

I do hereby certify that on November 1, 2013, I caused a true and correct copy of the above and foregoing instrument to be sent to the following parties in the manner indicated below:

James D. Peterson	<u>Email & U.S. Mail</u>
Jennifer L. Gregor	
GODFREY & KAHN, S.C.	
One East Main Street, Suite 500	
Madison, Wisconsin 53701-2719	

Pat Guest	<u>Email only</u>
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JT Griffin	<u>Email only</u>
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JT Brocksmith	<u>Email only</u>
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/s/ S. Max Harris

1637-5:mh

DISTRICT COURT
FILED

IN THE DISTRICT COURT OF TULSA COUNTY
STATE OF OKLAHOMA

OCT 31 2013

SALLY HOWE SMITH, COURT CLERK
STATE OF OKLA. TULSA COUNTY

WOHALI OUTDOORS, LLC,

Plaintiff,

vs.

SHELTERED WINGS, INC.

Defendant.

JURY TRIAL DEMANDED

Case No. **CL-2013 05008**

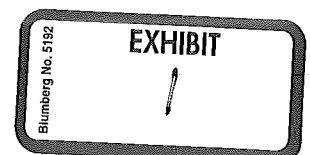
Judge **DANA LYNN KUEHN**

PETITION

The Plaintiff, Wohali Outdoors, LLC, ("Plaintiff" or "Wohali"), asserts the following claims and causes of action against the Defendant, Sheltered Wings, Inc. ("Defendant" or "Wings").

JURISDICTION AND VENUE

1. Wohali is an Oklahoma limited liability company with its principal place of business in Tulsa County, Oklahoma.
2. Defendant is a Wisconsin corporation.
3. Defendant has availed itself to the State of Oklahoma and has caused damages to Wohali in the State of Oklahoma.
4. Wohali's damages associated with the relevant facts, actions and circumstances stated below all occurred in the State of Oklahoma.
5. This Court has jurisdiction over Wohali, the Defendant and the subject matter of this action.
6. Venue is proper in the District Court in and for Tulsa County.



STATEMENT OF PRINCIPAL FACTS

7. On January 11, 2011, Wohali's Steel Eagle mark was registered and assigned Registration No. 3,904,929.

8. Subsequently, Defendant applied to the USPTO for the mark "Eagle". The USPTO rejected Defendant's application.

9. Defendant then filed the "Federal Suit"¹ against Wohali seeking (among other things) damages, injunctive relief and the cancellation of Wohali's Steel Eagle mark (Registration No. 3,904,929, referenced above). Defendant has claimed it was not aware of Wohali's Steel Eagle mark until the USPTO examiner identified Wohali's mark in response to Defendant's application to register Eagle.

10. Defendant's Complaint filed in the Federal Suit contained false misrepresentations concerning Defendant's pleaded marks as alleged therein.

11. On May 23, 2011, Wohali filed its Answer and Affirmative Defenses in the Federal Suit.

12. On June 6, 2011, Defendant filed a motion to dismiss the Federal Suit. On July 25, 2011, the District Court dismissed the Federal Suit. Defendant subsequently admitted it no longer wanted to litigate in Federal Court because Wohali was being defended by its insurance carrier.

13. On October 10, 2011, Defendant filed its Petition in Cancellation No. 92054629 before the USPTO ("Cancellation Proceeding"). Defendant moved to cancel Wohali's Steel Eagle mark (Registration No. 3,904,929) based on the alleged existence of five of Defendant's

¹ *Sheltered Wings, Inc. v. Wohali Outdoors, LLC*, Case No. 11-CV-300, U.S. District Court for the Western District of Wisconsin (the "Federal Suit").

pleaded marks. (Wohali denies the validity and existence of each of Defendant's pleaded marks.)

14. On August 24, 2012, Defendant moved to amend its Petition and admitted that as to three of its pleaded marks, Defendant could not maintain any claims.

15. Concerning one of Defendant's pleaded marks, the USPTO rejected Defendant's application. Addressing the USPTO's concerns, Defendant stated that the term "Eagle" with respect to optics is a weak mark. In both the Federal Suit and the Cancellation Proceeding, Defendant has attempted in bad faith to reverse course, and claim otherwise.

16. Defendant has made false representations in an effort to harm Wohali and maliciously interfere with the business of Wohali.

17. On November 3, 2011, Wohali filed another application with the USPTO to register Steel Eagle. The application was assigned Serial No. 85-464,085.

18. On May 16, 2012, Defendant filed a Notice of Opposition (Opposition No. 91205187) before the USPTO and opposed Wohali's application. Defendant's Opposition was filed in bad faith, was malicious and was filed with the purpose to harm Wohali.

19. On July 23, 2012, Wohali filed a separate application with the USPTO to register Steel Eagle. The application was assigned Serial No. 85-684,377. Subsequently, Defendant, in bad faith and in an effort to cause Wohali harm, filed multiple applications for marks with the USPTO, each utilizing the term "Eagle".

20. On January 11, 2013, Defendant filed a second Notice of Opposition (Opposition No. 91208804) against Wohali, and opposed Wohali's application (Serial No. 85-684,377). This Opposition was filed in bad faith, was malicious and was filed with the purpose to harm Wohali.

21. Defendant's principals admitted that Defendant has made false and misleading

statements concerning its pleaded marks at issue before the USPTO. Defendant has interfered with the business relations and expectancy of Wohali. Defendant has made false statements and performed malicious and unjustified acts with the purpose of causing Wohali harm and to unlawfully coerce and extract concessions from Wohali. Defendant has in fact made false representations to other individuals and businesses to coerce and force others to make concessions or cease doing business.

MALICIOUS INTERFERENCE WITH BUSINESS RELATIONS

22. Wohali incorporates by reference as if fully stated herein, all allegations asserted above in paragraphs 1-21. Wohali further incorporates by reference all allegations, claims and counts made in this Petition into each and every other allegation, claim and count of this Petition.

23. Wohali has the right to conduct and prosecute a lawful business without interference from Defendant. Wohali has business relations and an expectancy for which Defendant has interfered.

24. Defendant has interfered with Wohali's right to conduct business with the purpose of causing harm to Wohali.

25. Defendant's actions were intentional and aimed at causing harm to Wohali. Defendant's interference was not justified, privileged or excusable.

26. Defendant has engaged in acts and conduct designed to interfere with and disrupt Wohali's business. Defendant acted intentionally and with malice toward Wohali in interfering with Wohali's business. Alternatively, Defendant acted with reckless disregard for the rights of Wohali.

27. Defendant's actions have caused Wohali damages, namely Wohali's business has been actually interfered with and disrupted, and this harm was directed to and occurred within

Oklahoma. Defendant was aware of these business relations and expectancy. Moreover, Defendant's actions have caused Wohali to hire legal counsel.

28. Wohali has been damaged in an amount to be determined with specificity at trial in an amount greater than ten thousand dollars, and less than the amount required for diversity jurisdiction pursuant to Section 1332 of Title 28 of the United States Code. See 12 O.S. § 2008. Alternatively, Wohali seeks nominal damages.

29. Wohali seeks the maximum amount of punitive damages allowed by Oklahoma law and/or pursuant to 23 O.S. §9.1.

INTENTIONAL INTERFERENCE WITH BUSINESS RELATIONS

30. Wohali incorporates by reference as if fully stated herein, all allegations asserted above in paragraphs 1-29. Wohali further incorporates by reference all allegations, claims and counts made in this Petition into each and every other allegation, claim and count of this Petition.

31. Wohali has the right to conduct and prosecute a lawful business without interference from Defendant. Wohali has a valid expectancy.

32. Defendant has interfered with Wohali's right to conduct business by filing and pursuing bogus proceedings with the purpose of causing harm to Wohali.

33. Defendant's actions were intentional and aimed at causing harm to Wohali. Defendant's interference was not justified, privileged or excusable.

34. Defendant has engaged in acts and conduct designed to interfere with and disrupt Wohali's business. Defendant acted intentionally and with malice toward Wohali in interfering with Wohali's business. Alternatively, Defendant acted with reckless disregard for the rights of Wohali.

35. Defendant's actions have caused Wohali damages, namely Wohali's business has been actually interfered with and disrupted. Moreover, Defendant's actions have caused Wohali to hire legal counsel.

36. Wohali has been damaged in an amount to be determined with specificity at trial in an amount greater than ten thousand dollars, and less than the amount required for diversity jurisdiction pursuant to Section 1332 of Title 28 of the United States Code. See 12 O.S. § 2008. Alternatively, Wohali seeks nominal damages.

37. Wohali seeks the maximum amount of punitive damages allowed by Oklahoma law and/or pursuant to 23 O.S. §9.1.

INTERFERENCE WITH PROSPECTIVE ECONOMIC ADVANTAGE

38. Wohali incorporates by reference as if fully stated herein, all allegations asserted above in paragraphs 1-37. Wohali further incorporates by reference all allegations, claims and counts made in this Petition into each and every other allegation, claim and count of this Petition.

39. Wohali has the right to conduct and prosecute business relations without interference from Defendant.

40. Wohali has a valid expectancy.

41. Defendant had knowledge of Wohali's business relations and expectancy at the time Defendant interfered with same.

42. Defendant has interfered with Wohali's business relations and expectancy, and has caused harm to Wohali.

43. Defendant's actions were intentional and aimed at causing harm to Wohali. Defendant knew that its actions would interfere with Wohali's business and expectancy. Defendant's interference was not justified, privileged or excusable.

44. Defendant has engaged in acts and conduct designed to interfere with and disrupt Wohali's business relations and expectancy. Defendant acted intentionally and with malice toward Wohali in interfering with Wohali's rights. Alternatively, Defendant acted with reckless disregard.

45. Defendant's actions have caused Wohali damages, namely Wohali's expectancy and rights have been actually interfered with and disrupted. Moreover, Defendant's actions have caused Wohali to hire legal counsel.

46. Wohali has been damaged in an amount to be determined with specificity at trial in an amount greater than ten thousand dollars, and less than the amount required for diversity jurisdiction pursuant to Section 1332 of Title 28 of the United States Code. See 12 O.S. § 2008. Alternatively, Wohali seeks nominal damages.

47. Wohali seeks the maximum amount of punitive damages allowed by Oklahoma law and/or pursuant to 23 O.S. §9.1.

ABUSE OF PROCESS

48. Wohali incorporates by reference as if fully stated herein, all allegations asserted above in paragraphs 1-47. Wohali further incorporates by reference all allegations, claims and counts made in this Petition into each and every other allegation, claim and count of this Petition.

49. Defendant brought its actions challenging Wohali's Steel Eagle mark and applications, premised on ulterior motives.

50. Defendant commenced these actions and has pursued its claims for an ulterior purpose. In other words, Defendant has used these actions for a purpose for which the process was not designed. The primary objective of Defendant is for a purpose for which the process was not designed.

51. The purpose of these actions was not for the purpose of opposing Wohali's mark and applications, but rather for the ulterior purpose of interfering with the business and contractual relations of Wohali as well as Wohali's expectancy, with the purpose of causing Wohali harm, financial and otherwise.

52. Defendant filed and pursued these actions, not to oppose Wohali's applications, but instead to cause Wohali harm, financial and otherwise.

53. By interfering with and causing harm to Wohali, Defendant intended to harm Wohali to the point of not being able to continue its business. Defendant's actions are intentional and malicious; and not privileged or justified.

54. Wohali has been damaged in an amount to be determined with specificity at trial in an amount greater than ten thousand dollars, and less than the amount required for diversity jurisdiction pursuant to Section 1332 of Title 28 of the United States Code. See 12 O.S. § 2008. Alternatively, Wohali seeks nominal damages.

55. Wohali also seeks the maximum amount of punitive damages allowed by Oklahoma law and/or pursuant to 23 O.S. §9.1.

UNFAIR COMPETITION

56. Wohali incorporates by reference as if fully stated herein, all allegations asserted above in paragraphs 1-55. Wohali further incorporates by reference all allegations, claims and counts made in this Petition into each and every other allegation, claim and count of this Petition.

57. There is no justification for Defendant's interference with Wohali's business and contractual relations, nor with Wohali's expectancy. Defendant's acts have interfered with and were and are intended to interfere with Wohali's business.

58. Defendant acted intentionally and with malice toward Wohali. Alternatively, Defendant acted with reckless disregard for the rights of Wohali.

59. Wohali has been damaged in an amount to be determined with specificity at trial in an amount greater than ten thousand dollars, and less than the amount required for diversity jurisdiction pursuant to Section 1332 of Title 28 of the United States Code. See 12 O.S. § 2008. Alternatively, Wohali seeks nominal damages.

60. Wohali also seeks the maximum amount of punitive damages allowed by Oklahoma law and/or pursuant to 23 O.S. §9.1.

JURY TRIAL DEMANDED

Wohali hereby demands a Jury Trial on all issues properly triable by Jury.

PRAYER

Wohali prays for the following relief:

1. Monetary damages to be determined with specificity at trial in an amount greater than ten thousand dollars, and less than the amount required for diversity jurisdiction pursuant to Section 1332 of Title 28 of the United States Code. See 12 O.S. § 2008. Alternatively, Wohali seeks nominal damages.

2. Punitive damages in the maximum amount allowed by Oklahoma law and/or 23 O.S. §9.1.

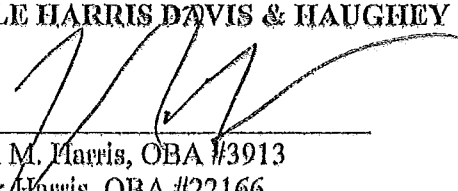
3. Injunctive relief to preclude Defendant from continuing to perform unlawful and malicious acts.

4. Attorneys' fees, interest, and all costs and expenses.

5. All other relief to which Wohali is entitled.

Respectfully Submitted,

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